

REMARKS

Election/Restrictions

The examiner acknowledged applicant's election of Group I, claims 7-12 and 19. The election was treated as an election without traverse.

Specification

The disclosure was objected to due to informalities because the Sequence Listing was in conflict with the sequences identified in the claims. Applicant has amended the claims to remove the inconsistency.

The specification was found to refer to other U.S. Patent Applications, in particular to pending U.S. Patent Application Serial No. 08/864,224, but the current status of same was not indicated. Correction was required.

Applicant has amended the specification to provide the current status of U.S. Patent Application Serial No. 08/864,224.

Claim rejections – 35 U.S.C. § 112

Claims 7-12 and 19 were rejected under 35 U.S.C. § 112, first paragraph, as contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the invention at the time the application was filed because the Sequence listing and the sequences identified in the claims were in conflict.

Applicant has amended Claims 7, 8 and 10 so that the correct sequences of the Sequence Listing are now identified in the Claims. Accordingly, applicant respectfully requests

reconsideration by the examiner and withdrawal of the claim rejections under 35 U.S.C. § 112, first paragraph.

Claim rejections – 35 U.S.C. § 102

Claims 7-12 and 19 were rejected under 35 U.S.C. § 102(f) on the basis that the inventors did not invent the invention. The examiner cites the Sanchez, et al., paper in *Science* (1977) as describing the efforts of at least 8 individuals in the isolation of what appears to be the now claimed amino acid sequence and that the six co-authors other than the inventors of the present invention appear to have been integrally involved in the development of the invention now claimed.

In response, applicant encloses herewith a Declaration under 37 C.F.R. § 1.132 by Stephen Elledge declaring that the present inventors are the inventors of the invention now claimed. The *Science* paper relied upon by the examiner was a scientific research paper, the subject matter of which is not identical to the now claimed invention.

Specifically, the instant claims are directed to amino acid sequences that were invented solely by the present inventors. The other six co-authors of the *Science* paper did not contribute to the identification of the claimed sequences. The six non-inventor co-authors contributed to the analysis and characterization of Cdk regulation described in the paper, but did not contribute to the identification and isolation of the sequences instantly claimed. Applicant respectfully believes, therefore, that the present inventors are the true and correct inventors. Further, applicant respectfully submits that, in view of the invention now claimed, that it would jeopardize the validity of the present claims to alter the inventorship of the present application.

The applicant respectfully submits that the examiner may correctly distinguish between the contents of the cited *Science* paper, taken in its entirety, and the scope of the instant claims. That is, the *Science* paper addresses research questions that, while including the subject matter of the instant claims, also extend beyond the scope of the instant claims. It is proper that the present inventors make the same distinction and limit their inventorship only to the proper scope of that which they invented. The application properly reflects the accurate inventorship of the claimed invention.

Applicant, therefore, respectfully requests reconsideration by the examiner and withdrawal of the claim rejections under 35 U.S.C. § 102(f). Applicant believes that the claims as amended are now in condition for allowance and respectfully requests advancement of the application to allowance.

CONCLUSION

In view of the foregoing amendments and remarks it is respectfully submitted that this application and all pending claims therein are in condition for allowance and such is courteously requested.

Respectfully submitted,

GARDERE WYNNE SEWELL LLP

Date: Feb. 7, 2001.

By: Matthew E. Burr
Matthew E. Burr
Registration No. 37,591

ATTORNEY FOR APPLICANT

1601 Elm Street, Suite 3000
Dallas, Texas 75201
(214) 999-4632 - Telephone
(214) 999-4667 - Facsimile

In re Application of: Stephen J. Elledge

Serial No: 09/488,364

Filed: January 12, 2000

Examiner: B. Sisson

Entitled: "MAMMALIAN CHECKPOINT GENES AND PROTEINS"

Specification marked-up in accordance with Rule 1.121(c):

--described in co-pending U.S. Patent Application Serial No. 08/864,224, now issued as U.S. Patent No. 5,851,808, - -

In re Application of: Stephen J. Elledge

Serial No: 09/488,364

Filed: January 12, 2000

Examiner: B. Sisson

Entitled: "MAMMALIAN CHECKPOINT GENES AND PROTEINS"

Claims marked-up in accordance with Rule 1.121(c):

7. AMENDED) A purified protein encoded by the nucleotide sequence of [Claim 1] SEQ ID NO: 3.

8. (AMENDED) A purified protein comprising the amino acid sequence set forth in SEQ ID NO: [3] 1.

10. (AMENDED) The fusion protein of claim 9, wherein said Chk1 protein comprises at least a portion of SEQ ID NO: [3] 1.

DALLAS 974717v1